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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,790	06/17/2005	Jutta Arden-Jacob	ARDEN-JACOB-3	4872
20151 7590 05/16/2008 HENRY M FEIEREISEN, LLC 350 FIFTH AVENUE SUITE 4714 NEW YORK, NY 10118				
EXAMINER				
POWERS, FIONA				
ART UNIT		PAPER NUMBER		
1626				
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05/16/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/539,790

**Applicant(s)**

ARDEN-JACOB ET AL.

**Examiner**

Fiona T. Powers

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-24 and 26-33 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1 to 11, 14 and 21 to 24 (all in part) and claim 12, drawn to compounds of the formula I where Y is oxygen and process for the preparation thereof.

Group 2, claim(s) 1 to 11, 13, 14, 16 and 21 to 24 (all in part), drawn to compounds of the formula I where Y is sulfur and process for the preparation thereof.

Group 3, claim(s) 1 to 11, 13, 14, 16 and 21 to 24 (all in part), drawn to compounds of the formula I where Y is selenium and process for the preparation thereof.

Group 4, claim(s) 1 to 11, 13, 14, 16 and 21 to 24 (all in part), drawn to compounds of the formula I where Y is  $\text{CR}_a\text{R}_b$  and process for the preparation thereof.

Group 5, claim(s) 1 to 11, 14 and 21 to 24 (all in part), drawn to compounds of the formula I where Y is  $\text{NR}_c$ .

Group 6, claim(s) 1 to 11, 14 and 21 to 24 (all in part), drawn to compounds of the formula I where Y is a direct linkage and process for the preparation thereof.

Group 7, claim(s) 1 to 11, 14 and 21 to 24 (all in part), drawn to compounds of the formula I where Y is  $\text{R}_{14}$  and  $\text{R}_{15}$  and process for the preparation thereof.

Group 8, claim(s) 17 to 20 (all in part), drawn to a multichromophore system where Y is oxygen.

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Group 9, claim(s) 17 to 20 (all in part), drawn to a multichromophore system where Y is sulfur.

Group 10, claim(s) 17 to 20 (all in part), drawn to a multichromophore system where Y is selenium.

Group 11, claim(s) 17 to 20 (all in part), drawn to a multichromophore system where Y is  $CR_aR_b$ .

Group 12, claim(s) 17 to 20 (all in part), drawn to a multichromophore system where Y is  $NR_c$ .

Group 13, claim(s) 17 to 20 (all in part), drawn to a multichromophore system where Y is a direct linkage.

Group 14, claim(s) 17 to 20 (all in part), drawn to a multichromophore system where Y is  $R_{14}$  and  $R_{15}$ .

Group 15, claim(s) 26, 27 and 30 to 33 (all in part), drawn to a method using compounds where Y is oxygen.

Group 16, claim(s) 26, 27 and 30 to 33 (all in part), drawn to a method using compounds where Y is sulfur.

Group 17, claim(s) 26, 27 and 30 to 33 (all in part), drawn to a method using compounds where Y is selenium.

Group 18, claim(s) 26, 27 and 30 to 33 (all in part), drawn to a method using compounds where Y is  $CR_aR_b$ .

Group 19, claim(s) 26, 27 and 30 to 33 (all in part), drawn to a method using compounds where Y is  $NR_c$ .

Group 20, claim(s) 26, 27 and 30 to 33 (all in part), drawn to a method using compounds where Y is a direct linkage.

Group 21, claim(s) 26, 27 and 30 to 33 (all in part), drawn to a method using compounds where Y is  $R_{14}$  and  $R_{15}$ .

Group 22, claim(s) 28 and 29 (all in part), drawn to a conjugate of a compound of formula I where Y is oxygen.

Group 23, claim(s) 28 and 29 (all in part), drawn to a conjugate of a compound of formula I where Y is sulfur.

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Group 24, claim(s) 28 and 29 (all in part), drawn to a conjugate of a compound of formula I where Y is selenium.

Group 25, claim(s) 28 and 29 (all in part), drawn to a conjugate of a compound of formula I where Y is  $CR_6R_6$ .

Group 26, claim(s) 28 and 29 (all in part), drawn to a conjugate of a compound of formula I where Y is  $NR_6$ .

Group 27, claim(s) 28 and 29 (all in part), drawn to a conjugate of a compound of formula I where Y is a direct linkage.

Group 28, claim(s) 28 and 29 (all in part), drawn to a conjugate of a compound of formula I where Y is  $R_{14}$  and  $R_{15}$ .

The inventions listed as Groups 1 to 28 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the technical feature common to Groups 1 to 28 is the compounds of the formula I. This is not a special technical feature because they are known in the prior art. Note WO 00/64988 (Examples 5 and 16), WO 02/055512 (Examples 1, 5, 13 and 14), and EP 167998 (Examples 4 and 5), for example.

In addition, it would be an undue burden on the examiner if all of the groups were searched in a single application as separate patent, literature and computer searches would need to be done.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-

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272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fiona T. Powers/  
Primary Examiner, Art Unit 1626

Fiona T. Powers  
Primary Examiner  
Art Unit 1626

ftp  
May 14, 2008



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